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Paper No. 10
emc/ewh

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Mason Shoe Manufacturing Co.

Serial No. 75/404,671

Paul A. Welter of Merchant & Gould P.C. for Mason Shoe Manufacturing Co.

Jennifer M. Martin, Trademark Examining Attorney, Law Office 102 (Thomas Shaw, Managing Attorney).

Before Cissel, Hanak and Hairston, Administrative Trademark Judges.

Opinion by Hanak, Administrative Trademark Judge:

Mason Shoe Manufacturing Co. (applicant) seeks to register in typed drawing form SHOE MALL for "computerized online retail services in the field of footwear and clothing; retail catalog services in the field of footwear and clothing." The intent-to-use application was filed on December 12, 1997. Applicant has disclaimed the exclusive right to use SHOE.

The Examining Attorney has refused registration on the basis that applicant's mark, as applied to applicant's

services, is merely descriptive pursuant to Section 2(e)(1) of the Trademark Act.

When the refusal to register was made final, applicant appealed to this Board. Applicant and the Examining Attorney filed briefs. Applicant did not request a hearing.

As has been stated repeatedly, "a term is merely descriptive if it forthwith conveys an immediate idea of the ingredients, qualities or characteristics of the goods [or services]." In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 218 (CCPA 1978) (emphasis added); Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 189 USPQ 759, 765 (2nd Cir. 1976). A term is suggestive if it requires some thought to reach a conclusion as to the nature of the goods or services. Abcor Development Corp., 200 USPQ at 218.

In support of his refusal, the Examining Attorney relies upon dictionary definitions; excerpts of stories from the NEXIS database; printouts from selected websites; and eight third-party registrations.

The first dictionary relied upon by the Examining Attorney defines the word "mall" as follows: "A large, often enclosed shopping complex containing various stores, businesses, and restaurants usually accessible by common passageways." The American Heritage Dictionary of the English Language (3d ed. 1992). The second dictionary relied upon by the Examining Attorney defines the word "mall" as follows: "On the World Wide Web, a shopping

service that provides Web publishing space for business storefronts (Web pages that describe retail or service offerings). Malls typically offer credit-card ordering by means of secure servers and shopping carts, which enable users to select purchases and pay for them all when they are finished shopping." Webster's New World Dictionary of Computer Terms (7th ed. 1999).

As the preceding dictionary definitions make clear, a mall -- whether of the traditional kind or of the on-line kind -- is by definition a collection of various stores and businesses. Thus, the very dictionary definitions made of record by the Examining Attorney support applicant's contention that the word "mall" is somewhat incongruous when applied to a single retail service "because the term 'mall' is so well known as describing a multi-vendor shopping complex." (Applicant's reply brief page 6). Moreover, the vast majority of the remainder of the Examining Attorney's evidence also supports the notion that the word "mall" is associated with a "complex" (either of brick and mortar or online). For example, a story appearing in the April 11, 1997 edition of ASAP contains the following sentence: "In keeping with the window shopping motif, Net. Commerce also has the capacity to support an on-line mall, where vendors and merchants choose to conduct on-line commerce from connected sites."

Moreover, the Examining Attorney's website evidence also supports the concept that an on-line mall involves many

vendors, and not just a single vendor. For example, the Examining Attorney made of record pages from the Alta Vista browser which list various malls such as the Total Mall, Global Internet Shopping Mall and the Mall of Cyberspace. Again, this evidence supports the notion that the word "mall" is associated with a collection of vendors and not a single vendor.

Finally, with regard to the eight third-party registrations made of record by the Examining Attorney, these registrations are for marks containing the word "mall" which are registered on the Supplemental Register, or are registered on the Principal Register with a disclaimer of the word "mall." Two comments are in order. First, it appears that the Examining Attorney's search revealed that there were at least 30 registrations containing the word "mall." However, for whatever reasons, the Examining Attorney chose to make of record just eight third-party registrations. In addition, these eight registrations are not in order. Rather, they comprise "document numbers" 1, 3, 6, 19, 22, 23, 24 and 30. We are left to speculate as to whether the other third-party registrations were on the Principal Register without a disclaimer of the word "mall."

Second, in any event, these eight third-party registrations involve services provided by more than one entity. For example, the registration for the mark ENTREPRENEURS MALL is for the following service: "Disseminating of advertising for others, namely

manufacturers and service providers, via on-line electronic communications network." Registration Number 2,050,059. In other words, the very third-party registrations relied upon by the Examining Attorney which contained the word "mall" involve various manufacturers and service providers.

In short, the Examining Attorney's own evidence establishes that the word "mall" -- whether used in a traditional sense or in its on-line sense -- refers to a "complex" involving multiple stores and businesses. Accordingly, when used in conjunction with a single service provider (i.e. applicant), the term SHOE MALL, in its entirety, requires at least some thought to reach the conclusion that the services in question are being provided by a single entity and not by multiple entities.

In any event, to the extent that there are doubts on the issue of mere descriptiveness, it is the practice of this Board to resolve such doubts in applicant's favor. In re Gourmet Bakers, Inc., 173 USPQ 565 (TTAB 1972).

Decision: The refusal to register is reversed.